

PATENT COOPERATION TREATY

From the
INTERNATIONAL PRELIMINARY EXAMINING AUTHORITY

PCT

To:

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EINGANG / RECEIPT
29.03.2004

NOTIFICATION OF TRANSMITTAL OF
THE INTERNATIONAL PRELIMINARY
EXAMINATION REPORT

(PCT Rule 71.1)

Date of mailing
(day/month/year)

28.09.2004

Applicant's or agent's file reference
Case 21315

IMPORTANT NOTIFICATION

International application No.
PCT/EP 03/04892

International filing date (day/month/year)
09.05.2003

Priority date (day/month/year)
16.07.2002

Applicant
DSM IP ASSETS B.V.

1. The applicant is hereby notified that this International Preliminary Examining Authority transmits herewith the international preliminary examination report and its annexes, if any, established on the international application.
2. A copy of the report and its annexes, if any, is being transmitted to the International Bureau for communication to all the elected Offices.
3. Where required by any of the elected Offices, the International Bureau will prepare an English translation of the report (but not of any annexes) and will transmit such translation to those Offices.
4. **REMINDER**

The applicant must enter the national phase before each elected Office by performing certain acts (filing translations and paying national fees) within 30 months from the priority date (or later in some Offices) (Article 39(1)) (see also the reminder sent by the International Bureau with Form PCT/IB/301).

Where a translation of the international application must be furnished to an elected Office, that translation must contain a translation of any annexes to the international preliminary examination report. It is the applicant's responsibility to prepare and furnish such translation directly to each elected Office concerned.

For further details on the applicable time limits and requirements of the elected Offices, see Volume II of the PCT Applicant's Guide.

The applicant's attention is drawn to Article 33(5), which provides that the criteria of novelty, inventive step and industrial applicability described in Article 33(2) to (4) merely serve the purposes of international preliminary examination and that "any Contracting State may apply additional or different criteria for the purposes of deciding whether, in that State, the claimed inventions is patentable or not" (see also Article 27(5)). Such additional criteria may relate, for example, to exemptions from patentability, requirements for enabling disclosure, clarity and support for the claims.

Name and mailing address of the international
preliminary examining authority:



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PATENT COOPERATION TREATY



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REC'D 29 SEP 2004

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INTERNATIONAL PRELIMINARY EXAMINATION REPORT
(PCT Article 36 and Rule 70)

Applicant's or agent's file reference Case 21315	FOR FURTHER ACTION See Notification of Transmittal of International Preliminary Examination Report (Form PCT/PEA/416)	
International application No. PCT/EP 03/04892	International filing date (day/month/year) 09.05.2003	Priority date (day/month/year) 16.07.2002
International Patent Classification (IPC) or both national classification and IPC C08G77/38		
Applicant DSM IP ASSETS B.V.		
<p>1. This international preliminary examination report has been prepared by this International Preliminary Examining Authority and is transmitted to the applicant according to Article 36.</p> <p>2. This REPORT consists of a total of 5 sheets, including this cover sheet.</p> <p><input type="checkbox"/> This report is also accompanied by ANNEXES, i.e. sheets of the description, claims and/or drawings which have been amended and are the basis for this report and/or sheets containing rectifications made before this Authority (see Rule 70.16 and Section 607 of the Administrative Instructions under the PCT).</p> <p>These annexes consist of a total of sheets.</p>		
<p>3. This report contains indications relating to the following items:</p> <p>I <input checked="" type="checkbox"/> Basis of the opinion</p> <p>II <input type="checkbox"/> Priority</p> <p>III <input checked="" type="checkbox"/> Non-establishment of opinion with regard to novelty, inventive step and industrial applicability</p> <p>IV <input type="checkbox"/> Lack of unity of invention</p> <p>V <input checked="" type="checkbox"/> Reasoned statement under Rule 66.2(a)(ii) with regard to novelty, inventive step or industrial applicability; citations and explanations supporting such statement</p> <p>VI <input type="checkbox"/> Certain documents cited</p> <p>VII <input type="checkbox"/> Certain defects in the international application</p> <p>VIII <input type="checkbox"/> Certain observations on the international application</p>		
Date of submission of the demand 29.01.2004	Date of completion of this report 28.09.2004	
Name and mailing address of the international preliminary examining authority:  European Patent Office D-80298 Munich Tel. +49 89 2399 - 0 Tx: 523656 epmu d Fax: +49 89 2399 - 4465	Authorized Officer Buestrich, R Telephone No. +49 89 2399-7473 	

**INTERNATIONAL PRELIMINARY
EXAMINATION REPORT**

International application No. PCT/EP 03/04892

I. Basis of the report

1. With regard to the **elements** of the international application (*Replacement sheets which have been furnished to the receiving Office in response to an invitation under Article 14 are referred to in this report as "originally filed" and are not annexed to this report since they do not contain amendments (Rules 70.16 and 70.17)*):

Description, Pages

1-28 as originally filed

Claims, Numbers

1-12 as originally filed

2. With regard to the **language**, all the elements marked above were available or furnished to this Authority in the language in which the international application was filed, unless otherwise indicated under this item.

These elements were available or furnished to this Authority in the following language: , which is:

- ☐ the language of a translation furnished for the purposes of the international search (under Rule 23.1(b)).
☐ the language of publication of the international application (under Rule 48.3(b)).
☐ the language of a translation furnished for the purposes of international preliminary examination (under Rule 55.2 and/or 55.3).

3. With regard to any **nucleotide and/or amino acid sequence** disclosed in the international application, the international preliminary examination was carried out on the basis of the sequence listing:

- ☐ contained in the international application in written form.
☐ filed together with the international application in computer readable form.
☐ furnished subsequently to this Authority in written form.
☐ furnished subsequently to this Authority in computer readable form.
☐ The statement that the subsequently furnished written sequence listing does not go beyond the disclosure in the international application as filed has been furnished.
☐ The statement that the information recorded in computer readable form is identical to the written sequence listing has been furnished.

4. The amendments have resulted in the cancellation of:

- ☐ the description, pages:
☐ the claims, Nos.:
☐ the drawings, sheets:

5. ☐ This report has been established as if (some of) the amendments had not been made, since they have been considered to go beyond the disclosure as filed (Rule 70.2(c)).

(Any replacement sheet containing such amendments must be referred to under item 1 and annexed to this report.)

6. Additional observations, if necessary:

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III. Non-establishment of opinion with regard to novelty, inventive step and industrial applicability

1. The questions whether the claimed invention appears to be novel, to involve an inventive step (to be non-obvious), or to be industrially applicable have not been examined in respect of:

☐ the entire international application,

☐ claims Nos.

because:

☐ the said international application, or the said claims Nos. relate to the following subject matter which does not require an international preliminary examination (specify):

☒ the description, claims or drawings (*indicate particular elements below*) or said claims Nos. 12 are so unclear that no meaningful opinion could be formed (*specify*):

see separate sheet

☐ the claims, or said claims Nos. are so inadequately supported by the description that no meaningful opinion could be formed.

☒ no international search report has been established for the said claims Nos. 12

2. A meaningful international preliminary examination cannot be carried out due to the failure of the nucleotide and/or amino acid sequence listing to comply with the standard provided for in Annex C of the Administrative Instructions:

☐ the written form has not been furnished or does not comply with the Standard.

☐ the computer readable form has not been furnished or does not comply with the Standard.

V. Reasoned statement under Article 35(2) with regard to novelty, inventive step or industrial applicability; citations and explanations supporting such statement

1. Statement

Novelty (N)	Yes: Claims	1-11
	No: Claims	
Inventive step (IS)	Yes: Claims	1-11
	No: Claims	
Industrial applicability (IA)	Yes: Claims	1-11
	No: Claims	

2. Citations and explanations

see separate sheet

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EXAMINATION REPORT - SEPARATE SHEET**

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Re item III:

The subject-matter of independent claim 12 of the present application is unclear.
Claim 12 does not contain the essential features of the invention (Rule 6 PCT).

Re item V:

**Reasoned statement with regard to novelty, inventive step and industrial
applicability, Article 33(2) to (4) PCT**

D1: EP-A-1 081 140 (HOFFMANN LA ROCHE) 7 March 2001 (2001-03-07)
D2: EP-A-1 000 950 (HOFFMANN LA ROCHE) 17 May 2000 (2000-05-17)
D3: EP-A-0 709 080 (GIVAUDAN ROURE INT) 1 May 1996 (1996-05-01)

1. The subject-matter of claims 1-11 of the present application is novel in the sense of Art.33(2) PCT.

Documents D1 to D3 disclose polysiloxanes for sun screen compositions characterized by the structural elements (I), (II) and (III) of the present application (cf. D1, example 5; D2, examples 9,12 and 13 and D3, p.11).

The present application differs from D1 to D3 in that a structural element (IV) has to be necessarily present. In other words the silicon atoms must have a combination of methyl substituents, chromophore substituents and substituents which are neither methyl groups nor chromophores.

Furthermore, as can be seen from formula (IIIa), (IIIb), (IIIc) and (IIId), the polysiloxanes necessarily contain silicon atoms having a substituent $\text{CH}(\text{CH}_3)\text{R}_1$ or $\text{CH}_2\text{-CH}_2\text{-R}_1$ or $\text{C}(\text{=CH}_2)\text{R}_1$ or CH=CH-R_1 . These specific substituents are not disclosed in any documents D1 to D3.

Hence the subject-matter of claim 1-11 is novel over D1 to D3.

2. The subject-matter of claims 1-11 of the present application is inventive in the sense of Art.33(3) PCT.

Document D1 relates to polysiloxanes bearing chromophoric compounds and may therefore be regarded as closest prior art.

As already discussed, the present application differs from D1 in that a structural

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element (IV) has to be present necessarily.

The objective technical problem in view of D1 is the provision of further polysiloxanes for sun screen applications which allow more variation in the type of lipophilic substituent. The examples of the present application show the polysiloxanes with different lipophilic groups. There is no indication in the prior art, including D1 to D3, leading the skilled person to the claimed polysiloxane structures.

3. The subject-matter of claims 1 to 11 is industrial applicable in the sense of Art.33(4) PCT.